personal interview to discuss the rejections of record. At the end of July, 2003, Applicants' representative, Mark Sweet, spoke with Supervisory Patent Examiner ("SPE") Thibodeau, who informed Applicants' representative that Examiner Paulraj had left the examining corps. A request was then made to SPE Thibodeau to schedule an interview with another Examiner in his art unit.

In response, SPE Thibodeau suggested that Applicants file a Request for Continued Examination ("RCE") with an appropriate response, together with a request for a personal interview with the new Examiner assigned to handle this application. Accordingly, Applicants respectfully request that the newly assigned Examiner contact the undersigned attorney to schedule a personal interview prior to acting on this case.

REJECTION UNDER 35 U.S.C. § 102(b)

The Examiner maintains the rejection of claims 62-87 under 35 U.S.C. § 102(b) over WO 98/40170 ("Maag"). Applicants note that the Examiner is relying on U.S. Patent No. 6,333,077 as an English-language translation of Maag and all citations are to this U.S. Patent. Applicants respectfully traverse the rejection for the reasons already of record as well as those presented below.

In order to anticipate a claim, a reference must contain all elements of the claim. *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). Further, a single source must disclose all of the claimed elements "arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants respectfully submit that the Examiner has failed to establish that Maag teaches all the claim elements "arranged as in the claim."

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The Examiner relies on Maag for teaching a composition comprising a system A, which is thermally curable and a system B, which is curable under the action of high-energy radiation. Office Action dated October 3, 2002, at 4, and Abstract.

The system A comprises binders into which optionally reactive diluents and optionally crosslinking systems are incorporated. Col. 4, lines 45-60. "[T]wo or more complementary functionalities may simultaneously be present in system A.)" Col. 5, lines 47-49. A two-component system A comprises a hydroxy-functional binder, optionally a hydroxy-functional reactive diluent, while the crosslinking agent comprises free polyisocyanates. Col. 5, line 66, to col. 6, line 6. The Examiner relies on this teaching of polyisocyanates in formulating the rejection. Office Action dated October 3, 2002, at 4. System A "contains no free-radically polymerisable double bonds nor any groups capable of reacting in another way with free-radically polymerisable double bonds of system B)." Col. 2, lines 59-67. System B) comprises free-radically curing systems comprising prepolymers which "preferably contain no functional groups which can bring about crosslinking with constituents of system A)." Col. 7, line 63, to col. 8, line 2.

In view of these collective teachings, Applicants previously argued that Maag does not teach a composition comprising at least one second material comprising at least one thermally curable reactive functional group wherein the at least one second material comprises at least one vinyl group, as presently recited in independent claim 62. The Examiner attempts to rebut this argument by stating that "[w]hile this may be true with respect to system A), the system B) . . . is 'curable under the action of high-energy radiation by free-radical polymerization of olefinic double bonds,' and therefore,

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by its very definition, includes vinyl groups." Final Office Action dated April 11, 2003, at 3. The Examiner argues that the epoxy resin methacrylates "can satisfy the requirement of the claimed component b) comprising both a thermally reactive functional group and at least one vinyl group." *Id.*

As an initial matter, Applicants respectfully submit that the Examiner has misconstrued the claimed at least one second material recited in claim 62. In this claim, the at least one second material comprises at least one thermally curable reactive functional group. According to the language of this claim, if the second material has only one thermally curable reactive functional group, then the thermally curable reactive functional group is a vinyl group; if the second material has two or more curable reactive functional groups, then at least one of those groups is a vinyl group. Maag teaches no such material.

Second, Maag does not teach all the claim elements "arranged as in the claim." In particular, independent claim 62 is directed to a composition comprising at least one first material and at least one second material wherein each component is different. The Examiner argues that Maag anticipates this independent claim when one of ordinary skill in the art selects two different components from system B) of Maag, i.e., selecting epoxy resin methacrylates and a different prepolymer. However, this is not a teaching of the claim elements "arranged as in the claim."

Moreover, the Examiner has failed to point to the teaching in Maag of the at least one curing agent reactive with the at least one thermally curable reactive functional group, as recited in independent claims 62 and 76. In particular, the Examiner argues that the epoxy resin methacrylate of system B) of Maag is encompassed by the claimed

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at least one second material comprising at least one thermally curable reactive functional group. If the Examiner takes that position, then the Examiner must point to a teaching in Maag of a curing agent reactive with the epoxy resin methacrylate. Applicants respectfully submit that such a teaching does not exist.

While the Examiner has pointed to the teaching of polyisocyanates in system A) as possibly being encompassed by the claimed at least one curing agent, the Examiner may not rely on this teaching as a teaching of a curing agent for epoxy resin methacrylates used in Maag's system B). In particular, Maag clearly teaches that components of its system B "preferably contains no functional groups which can bring about crosslinking with constituents of system A)," such as the crosslinking agents comprising free polyisocyanates, previously relied upon by the Examiner. Col. 7, line 67, to col. 8, line 2, and col. 6, lines 1-5. For this reason, the Examiner has failed to point to the teaching of at least one curing agent reactive with the at least one thermally curable reactive functional group, as presently claimed.

For at least these reasons, the cited reference does not anticipate the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

The Examiner maintains the rejection of claims 1-61 under 35 U.S.C. § 103(a) over WO 98/40170 ("Maag") in view of U.S. Patent No. 5,077,083 ("Lutz"), U.S. Patent No. 5,939,491 ("Wilt"), U.S. Patent No. 6,245,833 ("Kang"), U.S. Patent No. 6,251,962 ("Desobry"), and U.S. Patent No. 6,207,235 ("Ohsawa"). Applicants respectfully traverse the rejection for the reasons already of record as well as those presented below.

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To establish a prima facie case of obviousness, three basic criteria must be met. These criteria include that the Examiner show there would have been some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify and combine reference teachings, and that the Examiner show that there would have been a reasonable expectation that the proposed modification will be successful. M.P.E.P. § 2143.02. If no such reasonable expectation of success exists, the proposed modification could not have been obvious. *Id.* Furthermore, the proposed modification cannot be considered obvious if it would render the prior art unsuitable for its disclosed purpose. M.P.E.P. § 2143.01. Applicants respectfully point out that neither requirement can be met for the combination and modification proposed by the Examiner.

The threshold for establishing a motivation to combine is high. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak,* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, it is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blue print for piecing together elements .... Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted).

The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge

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generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine,* 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added); *In re Sang-Su Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.").

Independent claim 1 is directed to a composition wherein at least one of component (a) (the first material) and/or component (b) (the second material) comprise at least one polysiloxane. As the Examiner admits, Maag neither teaches nor suggests a curable composition comprising at least one polysiloxane in either "system A)" or "system B)" of the disclosed composition. Office Action dated October 3, 2002, pages 5 and 6, sections 13 and 14.

1) Maag et al. in View of Lutz et al.

The Examiner alleged that it would have been obvious to "incorporate" Lutz's polysiloxanes into "system B)" of Maag's composition "to improve the curing, hardness and adhesive properties of the coating disclosed in Maag et al. See Lutz et al. col. 2, lines 19-27." Office Action dated October 3, 2002, page 5, section 13. Applicants respectfully disagree with the Examiner's conclusion.

The Examiner points to nothing in the cited art, or in knowledge generally available to the art, to suggest that adding Lutz's siloxanes into "system B)" of Maag's composition (as the Examiner proposes) would improve Maag's compositions. In particular, the Examiner has failed to point to the teaching or suggestion in Lutz that the

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improved properties relied upon by the Examiner are solely attributable to Lutz's polysiloxanes and would thus improve Maag's composition. In fact, Lutz clearly teaches that it is the composition in its entirety, which includes epoxy functional compounds, silanol functional compounds, a photoinitiator, and preferably a carbonol functional polysiloxane, that possesses the improved properties touted by Lutz. Col. 1, lines 10-15, and col. 2, lines 19-28. Thus, in order to rely on these touted properties as the basis for modifying the composition of Maag, one of ordinary skill in the art would have to add not only the silanol compounds, but all of the other required components as well. The addition of all of these other components would contain groups that would react with the free-radically polymerisable double bonds of system B) of Maag and would therefore not be permitted according to Maag's disclosure.

Accordingly, Applicants respectfully submit that the addition of Lutz's siloxanes for Maag's system B) could have been obvious under §103(a), and Applicants respectfully request that this rejection be withdrawn.

2) Maag et al. in View of Wilt et al.

The Examiner admits that Maag does not disclose that the thermally curable system A) can comprise the polysiloxanes recited in the instant claims. However, the Examiner alleges that one of ordinary skill in the art would have been motivated to add the polysiloxanes disclosed in Wilt et al. in the system A) of Maag because the use of these polysiloxanes would result "in curable compositions having excellent appearance, mar resistance, acid etch resistance, adhesion, pot life, tack time, and corrosion resistance (see abstract, col. 4-col. 6)." Office Action dated October 3, 2002, page 6, section 14. Applicants respectfully disagree.

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As explained above, Maag recites strict requirements for each component in Maag's system A) and system B). Components suitable for Maag's system A) must contain substantially no free-radically polymerisable double bonds and substantially no groups capable of reacting in another way with the free-radically polymerisable double bonds of system B (col. 4, lines 33-36). Maag discloses that the phrase "contains substantially no free-radically polymerisable double bonds and substantially no groups capable of reacting with free-radically polymerisable double bonds of system B) means that system B) "**contains no** free-radically polymerisable double bonds nor any capable of reacting in another way with free-radically polymerisable double bonds of system B)." Col. 2, lines 59-67 (emphasis added). The Examiner argues that he does not consider the one double bond in the side chain of Wilt's formula II to "be a substantial amount of free radically polymerisable double bonds." Office Action dated April 11, 2003, at 5. However, it is not for the Examiner to decide what amount would "substantially contribute to free-radical polymerization." Maag discloses that **no** amount should be in system A) and that would therefore exclude even one double bond located in a side chain of Wilt's polysiloxanes. Thus, Wilt's polysiloxanes could not satisfy Maag's requirements at least because these polysiloxanes would contain at least one free-radically polymerisable double bond. Consequently, it could not have been obvious to add Wilt's polysiloxanes in Maag's system A).

3) Maag et al. in view of Kang et al., Desobry, or Ohsawa et al.

Applicants respectfully submit that nothing in any of these three secondary references make up for the deficiencies in Maag set forth above with respect to independent claim 1. Specifically, nothing in Kang, Desobry, or Ohsawa would have led

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one of ordinary skill in the art to use at least one polysiloxane in either "system A)" or "system B)" of Maag's composition, nor does the Examiner allege that such a teaching exist in these secondary references.

Accordingly, Kang, Desobry, and Ohsawa each fail to make up for the deficiencies of Maag discussed above.

For at least the foregoing reasons, the cited references, alone or in combination, fail to render obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

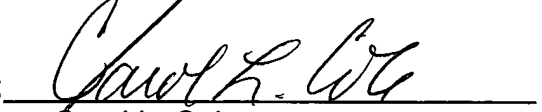
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: September 11, 20003

By: 

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